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REMARKS

MAR 18 2008

**Response to Claim Rejections Under 35 U.S.C. §103**

Claims 1 and 40-51 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Kieturakis (U.S. Pat. No. 5,794,626) in view of Tihon et al. (U.S. Pat. No. 5,415,656). The Examiner relies upon the '626 patent (Kieturakis) in this rejection contending that it teaches an encapsulation member with reference number 15. However, reference number 15 refers to a cutting member not an encapsulation member. Moreover, there is no teaching in the '626 reference that the element 15 would hold or otherwise secure the specimen to the distal shaft portion as required by the claims. In fact, the reference teaches away from this feature because the tissue severed by element 15 of the '626 patent must be small enough to be aspirated through apertures 55 in the distal shaft portion. The element 15 does not inherently do what the Examiner contends it does and there is no suggestion in the '626 patent that element 15 would perform that function. The Examiner has speculated that this element would perform the function, but has provided no evidence that it would in fact do so. The secondary reference, the '656 patent (Tihon et al.) fails to make up for what the '626 patent fails to teach, so the combination proposed by the Examiner fails to teach all the features of the claims and therefore does not support the Examiner's rejection.

Claim 29 was rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Ritchart et al. (U.S. Pat. No. 5,649,547) in view of Tihon et al. ('656). However, the encapsulating member (150) of Ritchart et al. extends beyond the distal end of the biopsy instrument to engage the specimen and pull the specimen within the inner lumen of the instrument. The encapsulating member (150) of Ritchart et al. fails to secure the specimen to the exterior of the distal shaft portion as called for by claim 29.

Tihon et al. also fails to teach securing the specimen to the exterior of the distal shaft portion, so again the combination does not teach all the claimed features.

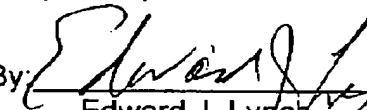
Claims 31-32 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Ritchart et al. ('547) in view of Tihon et al. ('656) further in view of Kieturakis ('626). However, the '626 patent fails to teach securing the separated specimen to the distal shaft portion, so the reference fails to make up for the deficiencies of the '547 and '656 patents and therefore the combination fails to support the Examiner's rejections.

Claim 33 was rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Ritchart et al. ('547) in view of Tihon et al. ('656) further in view of Jamshidi (U.S. Pat. No. 3,598,108). However, as discussed above, the '108 patent fails to teach securing the separated specimen to the distal shaft portion, so the reference fails to make up for the deficiencies of the '547 and '656 patents and therefore the combination fails to support the Examiner's rejections.

### Conclusion

Applicants believe that the pending claims are directed to patentable subject matter. Reconsideration and an early allowance of these claims are earnestly solicited.

Respectfully submitted,

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